

REMARKS/ARGUMENTS

Claims 1-36 are pending to the present application. Claims 1, 2, 4, 11, 12, 14, 21, 22, 24, 31 and 34 have been amended. No new claims have been added. Accordingly, claims 1-36 are currently under consideration. Amendment of certain claims is not to be construed as dedication to the public of any of the subject matter of the previously presented claims.

Further, while Applicants respectfully disagree with the grounds for rejection raised by the Examiner, in an effort to advance allowance, Applicants have amended the above referenced claims to overcome the Examiner's rejection. Applicants reserve the right to pursue any cancelled claim and/or any amended claim in its original form in a continuation application.

Claim rejections - 35 U.S.C. § 102(b)

Claims 1, 11, 21 and 31-36 stand rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Tsujimoto et al. (US2002/0190896A1) hereinafter Tsujimoto. Applicant respectfully traverses these rejections as hereinafter set forth.

A claim is anticipated only if each and every element as set forth in the claim is found either expressly or inherently described in a single prior art reference. *Verdegaal Brothers v Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Independent claims 1, 11, and 21 have been amended to include further limitations. Claim 1 as amended recites *inter alia* "transmitting a request message to the telemetry device requesting retrieval of data collected by the telemetry device according to a wireless protocol." Claim 11 as amended recites *inter alia* "the telemetry device responding to a request for retrieval of data collected by the telemetry device according to a wireless protocol." Support for the amendments to claim 1 and 11 can be found in original claim 2 and the specification for example at paragraphs 44-46. The device

operates over a wireless network, thus using a wireless protocol.

Claim 1 as amended also recites "receiving a response message containing the data from the telemetry device in response to the request message wherein a response window can be configured on the telemetry device and the telemetry device delays sending data using an offset in the response window." Claim 11 as amended further recites "sending a response message containing the data in response to the request message wherein a response window can be configured on the telemetry device and the telemetry device delays sending data using an offset in the response window." Support for these amendments can be found in original dependent claim 2, and the specification, for instance at paragraph 38.

Complementary amendments, to those made to claims 1 and 11, have been made to Claim 21.

Independent claims 31 and 34 have been amended to recite "obtaining assistance data for determining the location when the asset is inside a coverage area of the wireless network" and "switching to a second mode of operation when the asset is outside a coverage area of the wireless network for autonomously determining the location." Support for these amendments can be found in the specification, for example at paragraph 46.

With the above amendments, claims 1, 11, 21, and 31-36 are new and inventive over all of the prior art cited in the Office Action.

The Office Action cites Tsujimoto as anticipating original claims 1, 11, 21, 31-36. Tsujimoto describes a GPS system used in a cellular environment, and adapted to determine the position of a GPS terminal. A geolocation server is contemplated, that communicates aiding data to GPS terminal via a base station. A mode determinator, after reception of a network communication state input, determines if the network is available, and selects the adequate positioning mode, according to the positioning request, state of the GPS section and state of the network. Three modes are described: either a stand-alone mode, where the network is not available, or, where the network is available, a Network

Aiding Mode and a Server Centric Mode.

Tsujimoto does not disclose at least “using an offset in the response window” as recited in amended claims 1, 11, and 21 or “switching to a second mode of operation when the asset is outside a coverage area of the wireless network for autonomously determining the location time range for transmitting information from the telemetry device” as recited in amended claims 31 and 34.

Based on at least the reasons noted above, Applicants respectfully submits that claims 1, 11, 21, 31, and 34 as amended are not anticipated by Tsujimoto. Given that claims 32 and 33 depend from claim 31 and claims 35 and 36 depend from claim 34, it is respectfully submitted that these claims are also not anticipated by Tsujimoto for at least the same reasons.

Claim rejections - 35 U.S.C. § 103(a)

Claims 2-3, 5-9, 12-13, 15-19, 22-23, and 25-29 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Tsujimoto in view of U.S. Patent No. 6,331,825 to Ladner et al., hereinafter Ladner.

Claim 4, 14, and 24 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Tsujimoto in view Ladner and further in view of Jurgensen et al., hereinafter Jurgensen.

Claims 10, 20, and 30 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Tsujimoto in view of U.S. Patent No. 6,133,874 to Krasner hereinafter Krasner.

Applicant respectfully traverses these rejections as hereinafter set forth.

It is respectfully asserted that to establish a prima facie case of obviousness, three basic criteria must be met. MPEP §706.02(j). First, there should be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. *Id.* Second, there must be a reasonable expectation of success. *Id.* Finally, the prior art

reference (or references when combined) must teach or suggest all the claim limitations.
Id.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP §2143 - §2143.03 for decisions pertinent to each of these criteria.

The initial burden is on the Examiner to provide some suggestion of the desirability of doing what the inventor has done. MPEP §706.02(j). "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985).

It is further respectfully noted that the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *Ex Parte Kume, et al*, 2006 WL 2558178 (Bd. Pat. App. & Interf. 2006) citing to *In re Mills*, 916 F.2d 680, 16 USPQ 2d 1430 (Fed. Cir. 1990). Although the teaching-suggestion-motivation is test is no longer "rigidly applied," patent law precedent still requires that to find a combination obvious there should be at least an implicit motivation in the prior art to select the teachings of separate references and combine them to produce the claimed combination. *KSR International Co., v. Teleflex Inc., et al.*, 127 S.Ct. 1727, 1742, (U.S. 2007) citing to *Alza Corp. v. Mylan Labs., Inc.*, 464 F.3d 1286, 1291, (Fed. Cir. 2006) "the motivation to combine may be found "implicitly" in the prior art." Nevertheless, the Supreme Court continues to caution that "A fact finder should be aware, of course, of the distortion caused by hindsight bias and must be cautious of arguments reliant upon *ex post* reasoning" *KSR*, 127 S.Ct. at 1742 (citations omitted).

With the present response, dependent claims 4, 14, and 12 have been amended to further clarify the claims.

Claims 4 and 14 have been amended to recite *inter alia* "wherein the request message specifies a response window indicating a time frame for the telemetry device to respond to the request." The phrase "time range" has been replaced by the phrase "time frame." Support for this amendment can be found in the specification, for example at paragraph 69.

Claim 12 has been amended to clarify the wording "business logic." The claim now recites "a presentation server executing configured business rules and contain a business rules logic using this configuration to configure the telemetry device, acquire and process data from the telemetry device..." Support for this amendment can be found in the specification, for example at paragraph 62.

Claims 2-3, 5-9, 12-13, 15-19, 22-23, and 25-29

Claims 2-3 and 5-9 depend from claim 1. Claims 12-13 and 15-19 depend from claim 11. Claims 22-23 and 25-29 depend from claim 21. Each of these dependent claims includes all the limitations of the claims from which they depend.

As discussed above, claims 1, 11, and 21 as amended are not anticipated by Tsujimoto. Ladner does not cure the deficiencies of Tsujimoto. Ladner discloses a mobile system locator, and it describes a control center, a communication station, and a locator device, adapted to communicate via a pager and a cellular system. The locator system provides bidirectional communication between the communication station and the locator device. Furthermore, although Ladner describes the transmission of data within a time window, nothing is described for regulation on transmission as disclosed and claimed in the present application.

A Wireless Protocol message 501 includes a Response Window (or Data Window) field 501a to regulate the over-to-air transmission of the message from the telemetry device 103 to the NOC 101, as described previously. In other words, with the telemetry devices 103, accommodation is made to support staggering of device responses to prevent overwhelming the reverse path of the wireless network 107 (FIG. 1) if a command is sent to a large number of devices in a broadcast message. The Response Window field 501a is thus used to specify a desired time frame for obtaining responses

from deployed devices 103. If a Response Window is specified in a message, the device 103 delays sending its response using an Offset value within the Response Window when responding to the message. That is, after first processing the message, the device 103 delays sending the response to the message until the Offset time has expired. To ensure a good distribution of responses during the Response Window, the device 103, in an exemplary embodiment, can randomly select an Offset time within the specified time window.

Specification of Application No. 10/758770, Paragraph 69

Therefore, for at least the reasons discussed above, claims 2-3, 5-9, 12-13, 15-19, 22-23, and 25-29 are allowable over Tsujimoto in view of Ladner whether taken alone or in any reasonable combination.

Claims 4, 14, and 24

As discussed above, claims 1, 11, and 21 as amended are not anticipated by Tsujimoto. Applicants assert that Ladner further in view of Jurgensen does not cure the deficiencies of Tsujimoto. The cited passage of Jurgensen which discloses the general time frame structure or the time window of a random access channel does not cure the deficiencies of Tsujimoto for the independent claims nor is it properly combined with the cited art to teach "a response window indicating a time frame for the telemetry device to respond to the request, the response window specifying an offset value assigned to the telemetry device for transmitting the response message" as recited in claims 4, 14, and 24.

Claims 4, 14, and 24 depend from claims 1, 11, and 21 respectively. Therefore, even if Ladner and Jurgensen were combined with Tsujimoto the combination would neither teach nor suggest all of the elements as recited in claims 1, 11 and 21. Therefore, for at least the reasons discussed above, claims 4, 14, and 24 are allowable over Tsujimoto in view Ladner further in view of Jurgensen whether taken alone or in any reasonable combination.

Claims 10, 20, and 30

As discussed above, claims 1, 11, and 21 as amended are not anticipated by Tsujimoto. Applicants assert that Krasner does not cure the deficiencies of Tsujimoto. Krasner relates to data acquisition of satellite positioning system (SPS) data, in particular a method for searching and acquiring signals from SPS satellite. Claims 10, 20, and 30 depend from claims 1, 11, and 21 respectively. Therefore, even if Krasner were combined with Tsujimoto the combination would neither teach nor suggest all of the elements as recited in claims 1, 11 and 21. Therefore, for at least the reasons discussed above, claims 10, 20, and 30 are allowable over Tsujimoto in view Krasner whether taken alone or in any reasonable combination.

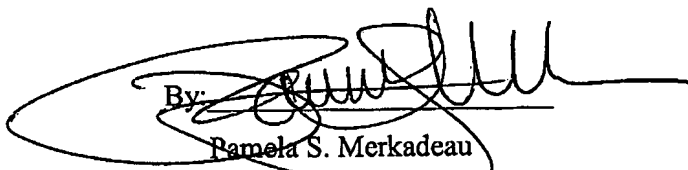
CONCLUSION

In view of the above, pending claims 1-36 are believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of these claims and to pass this application with all claims to issue. If it is determined that a telephone conference would expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at the number listed below.

In the event the U.S. Patent and Trademark office determines that an extension and/or other relief is required, Applicant petitions for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to Deposit Account No. 50-1847 referencing Docket No. 27048-038. However, the Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

October 26, 2007

Respectfully Submitted,

By: 
Pamela S. Merkadeau

Registration No. 53,318

MANATT, PHELPS & PHILLIPS LLP

1001 Page Mill Road, Building 2

Palo Alto, California 94304

650-812-1375 Telephone

650-213-0286 Facsimile

20191066.1